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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/003,037	11/02/2001	William D. Morgan	IAEC:006US/MTG	1213
7590 03/10/2004			EXAMINER	
FULBRIGHT & JAWORSKI L.L.P. A REGISTERED LIMITED LIABILITY PARTNERSHIP SUITE 2400 600 CONGRESS AVENUE AUSTIN, TX 78701			MENON, KRISHNAN S	
			ART UNIT	PAPER NUMBER
			1723	
DATE MAILED: 03/10/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/003,037

Applicant(s)

MORGAN ET AL.

Examiner

Krishnan S Menon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 20-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 20-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

This supplemental action is in response to the IDS filed by the applicant on 2/6/04, which crossed path with the final office action of 2/17/04. Information disclosed by the applicant in the IDS was considered in preparing this action, in addition to the claim rejections given in the final action, as detailed below.

Claims 1-18 and 20-32 are pending.

Drawings

The drawings were received on 1/02/04. These drawings are acceptable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-18 and 20-32 are rejected under 35 U.S.C. 102(b) as anticipated, or in the alternative, under 35 USC 103(a) as obvious as being on public use and/or sale in this country by the applicants more than one year prior to the date of application for patent.

Instant claims are directed towards a device as shown in the references C4 – C13 as admitted by the applicant in the IDS of 2/17/04 as on sale or public use more than one year before filing the application. The only element of the claims not clearly

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seen in these references is the service opening of claims 14, 15 and 24-27, which is shown by drawing 1-5, "Access Hatch" in reference C1, which is a proposal dated Nov 8, 1984, to build a membrane cover according to the specification provided by the solicitor (purchaser), and which belongs to a company by name ADI.

Applicants' declaration regarding the disclosure to Lemna Corporation is moot because, according to MPEP, public use or sale could be a "secret sale or offer to sell".

MPEP 2133.03

35 U.S.C. 102(b) "contains several distinct bars to patentability, each of which relates to activity or disclosure more than one year prior to the date of the application. Two of these - the public use' and the on sale' objections - are sometimes considered together although it is quite clear that either may apply when the other does not." *Dart Indus. v. E.I. du Pont de Nemours & Co.*, 489 F.2d 1359, 1365, 179 USPQ 392, 396 (7th Cir. 1973). There may be a public use of an invention absent any sales activity. Likewise, there may be a nonpublic, e.g., "secret," sale or offer to sell an invention which nevertheless constitutes a statutory bar. *Hobbs v. United States*, 451 F.2d 849, 859- 60, 171 USPQ 713, 720 (5th Cir. 1971).

It should be noted that 35 U.S.C. 102(b) may create a bar to patentability either alone, if the device in public use or placed on sale anticipates a later claimed invention, or in conjunction with 35 U.S.C. 103, if the claimed invention would have been obvious from the device in conjunction with the prior art.

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LaBounty Mfg. v. United States Int 'l Trade Comm 'n, 958 F.2d 1066, 1071, 22

USPQ2d 1025, 1028 (Fed. Cir. 1992)

2. Claims 1-13 and 16-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Wilson et al (US 4,438,863).

Wilson teaches a pond covering system with a membrane (figures, col 3 lines 3-7) having floatation members covered by the membrane (col 3 lines 20-54; 22,28-fig 4; fig 1; col 3 lines (26-29) and plurality of gas relief vents (col 3 lines 30-43; at 34-fig 4) as in instant claims 1 and 7. With ref to fig 4, a combination of one of the float 22 on the left and the membranes 10 on the right could be identified as the first membrane and the first float to read into claim 1, and the sleeve 28 covering the float 22 could be the compartment membrane.

Claim 16 defines a first membrane, a second membrane, a float whose width is less than 25% of the first membrane, and a gas relief vent defined by and between the first and second membrane. The floats (22-fig 4) which are completely covered by the membrane (28, which is of material same as that of 10) have space 32 between them forming a gas-collecting channel, with the spaces between the straps (34) and vent openings (38) carrying the gas to the gas pipe (36). The membrane is 10, and there are two of them – to the left and to the right of the floats 22. Floats 22 are narrower than the membrane (width <25% of the membrane). Therefore, as recited in claim 16, first and second membranes are coupled, with the gas relief passages between them. Re the

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second float coupled to the first membrane and a first elongated weight positioned on the upper surface between the first and second floats: see col 5 lines 33-38 and fig 7.

Claims depending from 1 and 16: The gas relief passage is elevated above the membrane level as in instant claim 6 (see fig 2 and 4). The floatation members are sealed inside the membrane as in instant claims 2-5, 17 and 18 (fig 2,4,6, 68- fig 8). A link member couples the floatation members as in instant claim 8 and 9 (40a-fig 4) with a weight (pipe 36-fig 4), and a second elongated member as in instant claim 10 and 20 (see 50-fig 7). The membrane is anchored by an anchor system as in instant claim 11 and 21 (col 3 lines 20-25), which comprises connectors coupled to the edge of the membranes as in instant claim 12 and 22 with sleeves as in instant claim 13 and 23 (20 fig 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 14, 15 and 24-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (863) in view of Ref C1 of the IDS of 2/17/04.

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Wilson (863) teaches the membrane cover of instant claims as in instant claims 1 and 7 above, except for the service opening. Drawing 1-5 "Access Hatch" of the ref C1 teaches an access opening with edge support floatation members and membrane coupled to the service opening extending down through the opening and having ballast weight attached. It would be obvious to one of ordinary skill in the art at the time of invention to use the teachings of ref C1 in the teachings of Wilson (863) to provide stable service openings for providing mechanical equipment, etc.

2. Claims 28-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (863) in view of Vogel et al (US6,136,194).

Wilson (863) teaches a method for venting pool with providing a membrane pool cover having one or more membranes and float supports sealed in the membrane, and with a series of gas vent openings as in instant claims 28-32 (see figures 1-10 and col 3 line 3-col 6 line 58). Wilson does not teach venting directly to the atmosphere. Vogel teaches venting gas vent passages directly to the atmosphere in a floating pool cover (col 3 lines 50-65), especially from the membrane edges (see figure2). It would be obvious to one of ordinary skill in the art at the time of invention to use the teaching of Vogel in the teaching of Wilson to vent the cover directly to the atmosphere, when separate collection of the gases as taught by Wilson is deemed unnecessary.

Conclusion

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Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 2/6/04 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609(B)(2)(i). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Krishnan S Menon whose telephone number is 571-272-1143. The examiner can normally be reached on 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L Walker can be reached on 571-272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Krishnan Menon
Patent Examiner


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